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DENNISON, MESEROLE, SCHEINER & SCHULTZ  
Suite 612  
1745 Jefferson Davis Highway  
Arlington, VA 22202

EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/835,495

Applicant(s)

OKOUCHI, KATSUMI

Examiner

Boyer D. Ashley

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 26 is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4, 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I and D, in Paper No. 9 is acknowledged. Although, the examiner strongly disagrees with the applicant the restriction requirement has been withdrawn.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "motor" and "cooling device/fan" (for example claims 8 and 9) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

4. The disclosure is objected to because of the following informalities: the sign "11b" in Figure 2 appears to be missing from the specification. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 4-7 and 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, it is not clear which portion is being referred to by the expression "the portion" because there is no antecedent basis for it and the expression "portion" is used for the side of the blade case.

In claim 5, there is no antecedent basis for "the lighting direction". Better language would be "wherein a direction of the light".

In claims 20 and 21, the expressions "the outer side" and "the outside" lack antecedent basis.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Bretthauer, U.S. Patent 3,104,688.

Bretthauer discloses the same invention as claimed including: a saw blade (12); a blade case (13/14) capable of covering the saw blade; and a light (15a) disposed within the blade case; said light is laterally displaced from the saw blade. It should be noted that the phrase "the light is substantially aligned with a cutting line of a workpiece

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that will be cut by the saw blade during a cutting operation" is merely functional/intended use as well as in terms of the workpiece that does not further define any specific structure of the apparatus but rather attempts to define the invention in terms of workpiece. Moreover, Bretthauer is fully capable of the light being substantially aligned with a cutting line of a workpiece during a cutting operation.

As to claim 2, Bretthauer discloses a mounting device capable of receiving the light and disposed within the blade case as clearly shown in Figure 2.

As to claim 3, Bretthauer discloses a side portion (14) that laterally opposes the saw blade with the mounting device disposed within the side portion as clearly shown in Figure 1.

9. Claims 1-13, 18-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Vavrik, U.S. Patent 3,104,688.

Vavrik discloses the same invention as claimed including: a saw blade (6); a blade case (1) capable of covering the saw blade; and a light (48) disposed within the blade case; said light is laterally displaced from the saw blade. It should be noted that the phrase "the light is substantially aligned with a cutting line of a workpiece that will be cut by the saw blade during a cutting operation" is merely functional/intended use as well as in terms of the workpiece that does not further define any specific structure of the apparatus but rather attempts to define the invention in terms of workpiece. Moreover, Bretthauer is fully capable of the light being substantially aligned with a cutting line of a workpiece during a cutting operation.

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As to claim 2, Vavrik discloses a mounting device (e.g. the entire inner structure) capable of receiving the light and disposed within the blade case as shown in Figure 2.

As to claim 3, Vavrik discloses a side portion (e.g. 7) that laterally opposes the saw blade with the mounting device disposed within the side portion as shown in Figure 4.

As to claims 4-7, Vavrik discloses a cover member (e.g. 9 or 49) for protecting the light and wherein a gap (space between the end of 49 and the workpiece) is maintained to permit light to be directed to the workpiece. Vavrik discloses a cover that encloses a portion of the power supply circuit (e.g. the wires/socket to the light).

As to claim 8, Vavrik discloses a cooling device (8) capable of cooling the light.

As to claim 9, Vavrik discloses a motor (2) and at least one vent (58) capable of cooling the motor.

As to claims 10-12, Vavrik discloses a portable circular saw with a base (12) and pivotally attached saw unit (1, see Figure 6).

As to claim 13, Vavrik discloses a cutting tool with a base (12), handle (see Figure 2), and a power supply circuit that are capable of balancing the cutting tool.

As to claim 18, Vavrik discloses a saw blade, blade case, a motor, and light as explained above and further including a power supply and coupling wherein the first circuit (e.g. the wires in the motor housing) and the second circuit portion (e.g. the terminals of the light bulb).

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***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bretthauer in view of Shikano et al., U.S. Patent 5,530,632, or Johnson, U.S. Patent 2,517,882.

Bretthauer discloses the invention substantially as claimed except for: the cooling device for cooling the light; however, Shikano et al. discloses that it is old and well known in the art to use cooling fans with hand held tools with enclosed lights for the purpose of preventing the device from overheating. Moreover, Johnson discloses that it is old and well known in the art to use fans with hand held cutting tools for directing air over a motor, light, and work surface for the purpose of removing debris from the work area. Furthermore, it should be noted that the device of Johnson functions as a cooling device because it draws air across the motor and light. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a cooling device with the device of Bretthauer in order to cooling the light and/or to remove debris from the work area.

12. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vavrik.

Vavrik discloses the invention substantially as claimed except for the power supply comprising a transformer; however, the examiner takes official notice that it is old and well known in the art to use transformers in power supplies for the purpose providing the specific amount voltage necessary to power the device (e.g. low volt lights). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a transformer with the device of Vavrik in order to use lower voltage lights with the device.

As to claim 15, the modified device of Vavrik lacks separate switches for the power switch (saw) and light switch wherein they are positioned adjacent each other. However, at the time of the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use separate switches for the blade and light in order to allow the light to help align the blade without the blade being activated because applicant has not disclosed that separate switches provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with two switches because both one and two switch devices perform the same function of allowing the saw and light to be powered. Therefore, it would have been an obvious matter of design choice to modify Vavrik to obtain the invention as specified in claim 15.



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***Allowable Subject Matter***

13. Claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

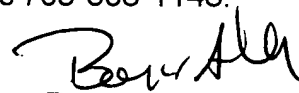
14. Claims 20 and 21 appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday thru Thursday between 7:30am and 6:00pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

  
**Boyer D. Ashley**  
**Primary Examiner**  
**Art Unit 3724**

bda  
January 23, 2003